

REMARKS

Applicants hereby add new claims 28-38. Accordingly, claims 1-38 are pending in the present application.

Claims 21-27 stand rejected under 35 USC 101 as being directed to non-statutory subject matter. Claims 1-20 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 6,430,711 to Sekizawa in view of U.S. Patent No. 6,405,178 to Manchala et al.

Applicants respectfully traverse the rejections and urge allowance of the present application.

With respect to the objection to the drawings, Applicants submit a copy of the postcard which accompanied the application as filed indicating the filing of five drawing sheets. Further, Applicants submit herewith a copy of Fig. 7 printed from the PTO website and indicating Fig. 7 was previously filed. Nonetheless, Applicants submit another copy of Fig. 7 herewith. MPEP §2163 I. (8th ed., rev. 2) states it is now well accepted that a satisfactory description may be in the claims or any other portion of the originally-filed specification and an applicant shows possession of the claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention (citations omitted). Applicants have amended the drawings for conformance with the originally-filed specification at page 14, line 1 spanning to page 15, line 11 in accordance with MPEP 2163.06 (8th ed., rev. 2) which provides that information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without adding new matter. Applicants request entry of Fig. 7 and approval of the specification in view of Fig. 7.

In addition, with respect to the statement that the figures show the computer instruction signal, Applicants refer to page 6, lines 26 + stating that the engine 14 may accept instructions as a computer instruction signal. Applicants have amended the specification at page 6 and Fig. 1 to illustrate an exemplary signal as reference 21 being accepted by hard copy output engine 14 as provided on page 6 of the specification. Applicants respectfully request withdrawal of the objection for at least the above-mentioned reasons.

Referring to the obviousness rejections, Applicants submit that to establish a

prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed., rev. 2).

Referring initially to the rejection of independent claim 1, the Office states that Sekizawa fails to disclose transmitting the electronic message across a firewall and relies upon the teachings of Manchala to cure the deficiencies. It is stated on page 5 of the Action that the motivation for combining the reference teachings is to restrict delivery to approved users. Applicants respectfully submit the alleged motivation is insufficient and the rejection of claim 1 is improper for at least this reason.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

The Office has failed to identify evidence of problems of Sekizawa with respect to sending mail to unapproved or unauthorized users. There is no evidence of record that a problem exists in Sekizawa. Without requisite objective evidence, the motivation is based upon improper subjective opinions of the Office or unknown authority.

Further, Applicants respectfully submit that the disclosed arrangement of

Sekizawa avoids problems regarding unapproved users getting delivery. More specifically, Sekizawa discloses a pulling arrangement wherein agent units 10 pull information from respective printers P as positively disclosed at col. 3, lines 44 stating the local monitor unit gets the status information from the machines to be monitored and at col. 21, lines 60+ where it is stated that the control section 15 of the agent unit 10 causes the local information getting section 11 to get the status information from printers P every first time period. The monitor interval T1 may be set at col. 24, lines 40+. Additional details of agent units pulling information from respective printers are described at col. 29, lines 1+.

Applicants respectfully submit that there is no objective evidence that unauthorized users are a problem or concern to Sekizawa especially in view of the structured pulling arrangement for implementing communications intermediate agent units 10 and printers P. There is no evidence of record that parties outside of the system are in communication with the printers to render the printers susceptible to unauthorized access. Applicants respectfully submit the Office has failed to identify objective evidence of record to support motivation for a proper prima facie rejection. Applicants respectfully submit that the 103 rejection of claim 1 is improper for at least this reason.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, referring to the rejection of dependent claim 2, the method recites wherein the transmitting comprises *transmitting the electronic message from an embedded web server contained in the peripheral device*. In formulating the 103 rejection of claim 2, the Office has failed to identify any teachings in the prior art of the *embedded web server contained in the peripheral device* as claimed. Applicants have electronically searched Sekizawa and have failed to uncover any teachings of an embedded web server contained in the peripheral device. Limitations of claim 2 are not disclosed nor suggested by the prior art and claim 2 is allowable for at least this reason.

Applicants have identified limitations of claim 2 which are not disclosed nor suggested by the teachings of the prior art identified by the Office. In the event that a rejection of the claims is maintained with respect to the prior art, or a new rejection

made, Applicants respectfully request identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R. §1.104(c)(2). In particular, 37 C.F.R. §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified*. Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. *When a reference is complex or shows or describes inventions other than that claimed by Applicants, the particular teachings relied upon must be designated as nearly as practicable*. Applicants respectfully request clarification of the rejections with respect to specific references and specific reference teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if claim 2 is not found to be allowable.

Referring to independent claim 8, there is no motivation to combine the teachings of Manchala with the teachings of Sekizawa and the rejection of claim 8 is improper for at least this reason.

The claims which depend from independent claim 8 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to independent claim 15, there is no motivation to combine the teachings of Manchala with the teachings of Sekizawa and the rejection of claim 8 is improper for at least this reason.

In addition, Sekizawa fails to disclose or suggest the *computer implemented control system for the hard copy output engine comprises processing circuitry configured to combine a unique device identifier relevant to the peripheral device with the status change* as defined in claim 15. The Office on page 4 of the Action relies upon the teachings of Fig. 22 as allegedly disclosing the claimed combining. However, Fig. 22 is a *communication formulated by agent unit 10 to console unit 20* as opposed to a communication from the printer and accordingly fails to disclose or suggest the claimed *combining by the control system for the hard copy output engine* as claimed. Accordingly, even if the prior art teachings are combined, the combination failed to disclose or suggest limitations of claim 15 and claim 15 is allowable for at least this additional reason.

The claims which depend from independent claim 15 are in condition for

allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to dependent claim 20, the Office states on page 6 of the Action that it is obvious to add the ordering feature of Manchala to Sekizawa in order to obtain a method of ordering consumables. Applicants respectfully disagree. More specifically, it is recited in claim 20 that the computer implemented control system for the hard copy output engine comprises a processor configured to determine that an order toner condition exists. Referring to Sekizawa at col. 3, lines 10 + , it is explicitly disclosed in Sekizawa that *ordering functions are implemented in an integrated monitor unit and therefore the printers can be constructed at low costs*. Further, at col. 10, lines 66 + , and col. 44, lines 4 + of Sekizawa it is stated that the processing time in the printers for transmitting status information is short *compared with transmission of an order to provide little impact to the function of the printers*. Further, at col. 46, lines 7 + it is stated that an operator of the *console unit 20* can monitor consumable consumptions and *supply the consumables to printers P eliminating any purpose of modifying the printers of Sekizawa to include the ordering feature of Manchala* as proposed by the Office. Sekizawa clearly discloses supplying consumables using the console unit 20 and not ordering consumables using the printers to reduce cost and provide simplified printers. Accordingly, Sekizawa is replete with teachings which teach away from the combination proposed by the Office and the 103 rejection of claim 20 is improper for this additional reason. Teaching away is the antithesis of the art's suggesting that the person of ordinary skill go in the claimed direction. Essentially, teaching away from the art is a *per se* demonstration of lack of obviousness. *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Referring to the 101 rejection of claim 27, Applicants respectfully submit the 101 rejection is improper and requests withdrawal of the rejection. For example, The *Training Materials* for the *Examination Guidelines for Computer-Related Inventions* cite the following as an example of a statutory claim:

Example 2: Signal Claim With Carrier Wave.

A computer data signal embodied in a carrier wave comprising a compression source code segment comprising [the code]; and an encryption source code segment comprising [the code].:

Accordingly, Claim 27 is a form of a signal claim with carrier wave which has been widely recognized and accepted by the Office as patentable. In addition, Applicant refers the Examiner to recently issued U.S. Patent Nos. 6,792,607; 6,791,971; 6,791,217; 6,789,108; 6,788,692; 6,788,681; 6,785,688; 6,785,609; 6,782,503; 6,779,114; 6,778,980; 6,778,653; 6,775,804; 6,775,581; 6,775,420; 6,774,987; 6,772,148 which also claim in varying forms data signal claims. This list is only exemplary and there are numerous other examples. To deny Applicant the same protections as afforded to other patentees is a violation of Applicant's rights under at least the equal protection clause of the 14th Amendment to the U.S. Constitution.

Referring to the 101 rejection of claims 21-27, Applicants respectfully request citation of authority in support of the position of the Office in accordance with the above-recited section of the CFR. The Office alleges on page 3 of the Action that a signal is interpreted as an abstract arrangement to be transmitted or as a transmission in transit, rather than a physical signal statically embedded in a computer readable medium. Signals are alleged to be non-statutory without the citation of any authority that the claims are non-statutory subject matter. If the claims 21-27 are not allowed, Applicants respectfully request citation of authority in support of the 101 rejection in a *non-final Action* so Applicants may appropriately respond.

Applicant respectfully submits that claims 21-27 are directed towards statutory subject matter as acknowledged by the Office by the issuance of numerous patents including data signal claims and Applicant requests withdrawal of the 101 rejection of claims 21-27 for at least this and the above compelling reasons.

Support for the new claims is provided at least by Figs. 1, 6 and 7 and the specification teachings of the respective figures of the present application.

Applicants include a copy of a previously filed Information Disclosure Statement. Applicants respectfully request forwarding of a form PTO-1449 of the IDS with initials thereon to Applicants

Applicants respectfully request allowance of all pending claims.


PDNO. 10007584-1
Serial No. 09/976,625
Amendment A

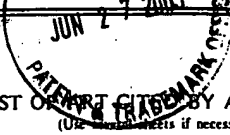
The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,

Robert E. Haines
Mark A. Harper

By:


James D. Shaurette
Reg. No. 39,833
Date: 6/22/05

| Form PTO-1449 | |  U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE | | ATTY. DOCKET NO. 10007584-1 | | SERIAL NO. Filed Concurrently Herewith | | |
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| LIST OF PRIOR ART CITATIONS BY APPLICANT (Use additional sheets if necessary) | | | | APPLICANT Robert E. Haines et al. | | FILING DATE Filed Concurrently Herewith | | |
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| U.S. PATENT DOCUMENTS | | | | | | | | |
| *Examiner Initial | | Document Number | Date | Name | Class | Subclass | Filing Date If Appropriate | |
| | AA | 6,192,410 | 02/20/01 | Miller | | | | |
| | AB | 6,081,900 | 06/27/00 | Subramaniam et al. | | | | |
| | AC | 5,657,390 | 08/12/97 | Elgamal et al. | | | | |
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| OTHER REFERENCES (including Author, Title, Date, Pertinent Pages, Etc.) | | | | | | | | |
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| *EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. | | | | | | | | |

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PDNO. 10007584-1
Inventors: Robert E. Haines et al.
Attorney: Jeff Limon 541-715-5979
Title: Unique Identifier for Customer Account and Method
ANNOTATED SHEET SHOWING CHANGES

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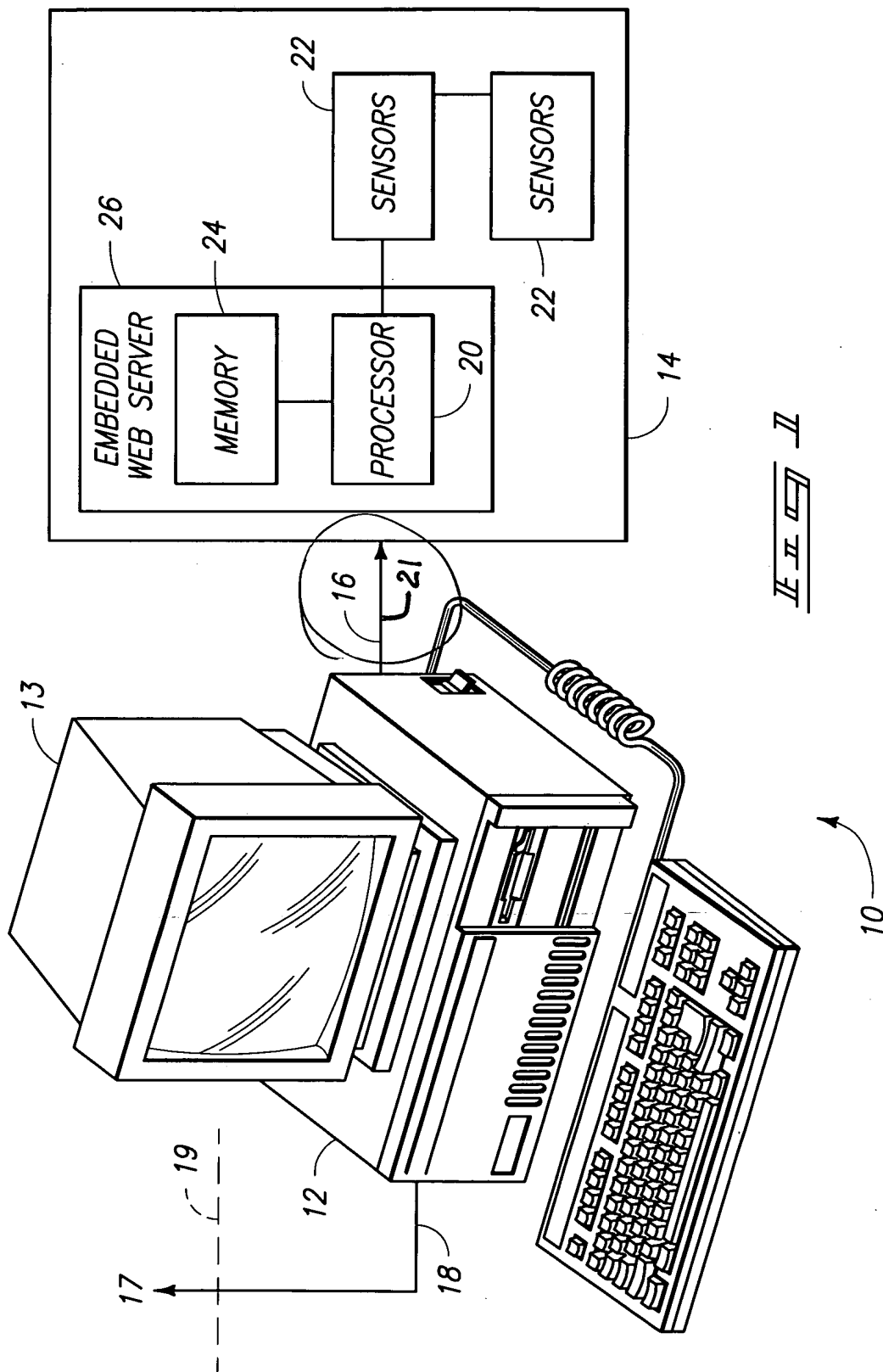


FIG. 1